

REMARKS

By the present amendment, claims 5, 17, and 24 have been amended to incorporate the subject matter of claim 29. Support for the added recitation is also found in claim 1. In addition, claims 10, 20 and 13, 22 have been amended accordingly to recite ranges of from 0.04 to 1 μm Ra and from 0.05 to 1 μm , respectively, and claims 11-12, 14-15, 21 and 29 have been canceled.

It is submitted that the amendment does not raise any new issues since they are based on previously presented claim 1 and presently canceled 29. Accordingly, entry and consideration of the amendment is respectfully requested.

Claims 1-10, 13, 16-20, 22-28, and 30-31 are pending in the application. Claims 1, 5, 17, and 24 are the only independent claims.

Claims 17-26 have been withdrawn from consideration following an election/restriction requirement. Consideration of claims 17-20 and 22-26 is again respectfully requested.

In the Office Action, claims 1-3, 9-12, and 27-28 are rejected under 35 U.S.C. 103(a) as obvious over WO 00/44841 to Nagahama et al. ("Nagahama") in view of US 5,972,473 to Arakawa ("Arakawa"), claim 4 is rejected under 35 U.S.C. 103(a) as obvious over Nagahama in view of Arakawa, further in view of US 6,111,699 to Iwata et al. ("Iwata"), claims 5-7, 13-16, and 29-31 are also rejected under 35 U.S.C. 103(a) as obvious over Nagahama in view of Arakawa, and claim 8 is rejected under 35 U.S.C. 103(a) as obvious over Nagahama in view of Arakawa, and further in view of Iwata.

It is alleged in the Office Action that the film in Arakawa is a transparent protective film "for the disclosed thicknesses" so there is a motivation to refer to Arakawa, that the range of 2-10 microns is exemplary only in Arakawa, that there is no evidence that such surface roughness

would “whiten” the film of Arakawa, and accordingly, that it would have been obvious to use the surface roughness of Arakawa in the optical element of Nagahama “for the purpose of reducing the friction coefficient of the surface of the film”.

Reconsideration and withdrawal of the rejections is respectfully requested. As a preliminary, it is submitted that there would have been no motivation to refer to Arakawa to modify Nagahama, because optical properties are conventionally required from a protective film, and Arakawa is silent as to the appropriate optical properties of its protective film. Namely, in the optical field, manufactured products undergo a visual inspection for the presence of any defect. These inspections are conventionally carried out with the protection film laminated on the optical product. Consequently, it is common technical knowledge that a protective film used with an optical element should have optical properties adapted so as not to cause interferences to the visual inspection of the manufactured product. As a result, a person of ordinary skill in the art would have no motivation to refer to Arakawa since optical properties are not relevant in the type of products to which the protective film of Arakawa is applied, and Arakawa itself is silent regarding possible optical properties of its protective films.

Further, even if, arguendo, a person of ordinary skill in the art were to refer to Arakawa, that person would have found in Arakawa an explicit teaching that the surface roughness should be “preferably approximately from 2 to 10 μm ” (Arakawa at col. 2, line 50). This teaching is not simply exemplary (as shown by the term “preferably”), but an indication of a workable range, as further evidenced by the Examples of Arakawa (surface roughnesses of 3, 10, 5, and 3 microns, respectively). In other words, a person of ordinary skill in the art would have confirmed by reading Arakawa that Arakawa is not concerned about optical properties of its protective film,

since, not only, it is completely silent regarding optical properties, but also, it recommends relatively high surface roughnesses. Thus, the person of ordinary skill in the art would have found absolutely no guidance in Arakawa as to whether a protective film of the type disclosed in Arakawa could be adapted in a form suitable to an optical member. Accordingly, there would have been no motivation to attempt such an adaptation, except in hindsight, because of the absence of suggestion and the absence of guidance as to whether such adaptation could be successfully attempted.

In contrast, the present inventors have determined that an outer surface roughness Ra of from 0.03 to 1 μm for a protective film to an optical member, as recited in present claims 1, 5, 17, and 24. Namely, the present inventors have surprisingly determined that, within the recited roughness range, optical properties required for a protective film applied to an optical member are still obtainable, while a satisfactory effect in terms of separation of plural optical members can be obtained also (see Examples of the present specification). This feature of the present invention and its advantages are not taught or suggested in any of Arakawa and Nagahama, and the other cited references fail to remedy these deficiencies. Therefore, the present claims are not obvious over the cited references taken alone or in any combination.

In view of the above, it is submitted that the rejection should be withdrawn.

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

In the event there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Serial Number: 10/015,991

Group Art Unit: 2872

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to our Deposit Account No. 50-2866.

Respectfully submitted,

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